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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,849	12/27/2000	Hideki Toshikage	7254/63304	4792

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EXAMINER
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CHEUNG, MARY DA ZHI WANG

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/749,849

Applicant(s)

TOSHIKAGE ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 24, 29, 34 and 39 recite "a channel having a surplus generated in a previously assigned data transfer rate per unit time". It is not clear what the surplus refers to? Does it refer to data, data transfer rate, bandwidth, or something else?

Claims 25-28, 30-33, 35-38 and 40-43 are rejected for incorporating the errors of their respective base claims by dependency.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-23, 44-48, 51-55, 58-61 and 64-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al., U. S. Patent 5,892,900.

As to claim 1, Ginter teaches an image commercial transactions system comprising (Fig. 1):

- a) A reception dealer for accepting a transfer of an image recorded on a recording medium in a predetermined format with a handling condition intrinsic to said image, and for transferring said image with said handling condition in a digital data format (column 53 lines 39-60 and column 54 lines 26-56 and Figs. 1, 15A);
- b) A charge accounting dealer for effecting an electronic charging accounting transaction for the transfer by said reception dealer of said data of said image with said handling condition (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

As to claim 2, Ginter teaches said reception dealer transfers said data of said image subjected to one of a scrambling processing and a masking process (column 59 lines 48-54 and column 150 lines 35-43).

As to claim 3, Ginter teaches said reception dealer subjects the data of said image to a scrambling process/enciphering, and transfers key data of the scrambling process/enciphering (column 59 lines 48-67).

As to claim 4, Ginter teaches said reception dealer transfers said image with said handling condition and an advertisement in a digital format (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 5, Ginter teaches said reception dealer transfers data of said advertisement synthesized with the data of said image and with said handling condition (column 317 lines 22-42 and column 320 lines 2-20).

As to claim 9, Ginter teaches said reception dealer generate predetermined additional information for the data of said image, and transfer said generated additional information in a digital format along with the data of said image with said handling condition (column 317 lines 22-42 and column 320 lines 2-20).

Claims 6-8 and 10-23 are rejected for the similar reasons as claims 1-5 and 9.

As to claim 44, Ginter teaches an image commercial transactions system comprising (Fig. 1):

- a) A distribution device for generating distributing image data based upon an image an image recorded on a predetermined recording media in a predetermined format and further generating distribution control data for said image based upon a handling condition intrinsic to said image recorded on said recording medium with said image, and for integrating the distributing said generated distribution image data and said generated distribution control data (column 53 lines 39-60 and column 54 lines 26-56 and Figs. 1, 5B, 15A);
- b) A display device for, based on said distribution image data and said distribution control data distributed by said distribution device, displaying on a display screen said image based on said distribution image data and distribution control details based on said distribution control data being correlated with each other (column 53 lines 39-60 and column 54 lines 26-56 and Figs. 1, 5B, 7, 15A).

As to claim 45, Ginter teaches said distribution control data is comprised of intrinsic control data generated when said image is recorded and additional control data for adding a predetermined process to said image data (column 53 lines 39-60 and column 54 lines 26-56 and column 317 lines 22-42 and column 320 lines 2-20 and Figs. 1, 5B, 15A).

As to claim 46, Ginter teaches said display device displays said intrinsic control data and details of said additional control data that are optionally selected (column 163 line 58 – column 164 line 5 and column 317 lines 22-42).

As to claim 47, Ginter teaches said display device displays said details of said intrinsic control data that are optionally selected (column 163 line 58 – column 164 line 5 and column 317 lines 22-42).

As to claim 48, Ginter teaches said display device displays details of said additional control data that are optionally selected (column 163 line 58 – column 164 line 5 and column 317 lines 22-42).

Claims 51-55, 58-61 and 64-68 are rejected for the similar reasons as claims 44-48.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 24-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of the present applicant 09/749,849.

As to claims 24-25, Ginter teaches an image commercial transactions system comprising (Fig. 1):

- a) A reception dealer for generating and sending predetermined image data to be distributed (column 53 lines 39-60 and column 54 lines 26-56 and Figs. 1);
- b) A distribution dealer for detecting, from among a plurality of channels for broadcasting predetermined data toward a satellite, and for distributing said image data sent from said reception dealer using one of the plurality of channels (column 53 lines 39-60 and column 54 lines 26-56 and column 62 lines 32-50 and Figs. 1, 15).
- c) A charge accounting dealer for effecting an electronic charging accounting transaction for distribution of said image data (column 55 lines 44-60 and column 58 lines 23-63 and Figs. 1A, 3-4).

Ginter does not specifically teach a channel having a surplus generated in a previously assigned data transfer rate per unit time, and distributing said image data using said channel having said detected surplus. The present application admits that the assigned transfer rate of each channel having a surplus is due to data compression (page 168). Ginter teaches data compression (column 68 lines 44-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the size of the compressed data of Ginter to be small enough to have a surplus so that the compressed data can be transferred even faster. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ginter to detect the channel having the surplus and use said channel to distribute the image data because it would not waste the unused bandwidth.

As to claim 26, the modified system of Ginter as discussed above does not specifically teach detecting said channel having said surplus according to the weather. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Ginter to detect the channel having said surplus according to the weather so that condition of the channel can be more accurately detected in the real environment.

As to claim 27, the modified system of Ginter as discussed above further teaches said reception dealer accepts a distribution of an image with a handling condition intrinsic to said image recorded on a predetermined recording medium in a predetermined format, and generates said image to be distributed from image data



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corresponding to said image and intrinsic control data based on said handling condition (column 53 lines 39-60 and column 54 lines 26-56 and Figs. 1, 15A).

As to claim 28, the modified system of Ginter as discussed above further teaches said recording medium is a photographic film, and said reception dealer generates said image data by optically scanning a photographic image on said photographic film and generates said intrinsic control data based on said handling condition recorded on said photographic file (column 53 lines 39-60 and column 54 lines 26-56 and column 59 lines 28-35 and Figs. 1, 7).

Claims 29-43 are rejected for the similar reasons as claims 24-28.

8. Claims 49-50, 56-57, 62-63 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Miodonski et al., U. S. Patent 6,414,679.

As to claim 49, Ginter teaches the images as discussed above. Ginter does not specifically teach the display device switches and displays an angle of view of said image optionally selected. Miodonski teaches displaying and viewing images from different angles (column 5 lines 38-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the image data of Ginter can be displayed from different angles so that the user can better view the image.

As to claim 50, Ginter teaches the display device displays a photographic image exposed on a photographic film as said image (column 59 lines 28-35).

Claims 56-57, 62-63 and 69-70 are rejected for the similar reasons as claims 49-50.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-70 are provisionally rejected under the judicially created doctrine of double patenting over claim 1-39 of copending Application No. 09/749,097. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

A reception dealer for accepting a transfer of an image recorded on a recording medium in a predetermined format with a handling condition intrinsic to said image, and for transferring said image with said handling condition in a digital data format; and a charge accounting dealer for effecting an electronic charging accounting transaction for

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the transfer by said reception dealer of said data of said image with said handling condition.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Inoue (U. S. Patent 6,196,896) discloses a transmission apparatus, a recording apparatus, a transmission and reception apparatus, a transmission method, a recording method and a transmission and reception method by which data can be communicated between different apparatus over a single data bus in accordance with a first communication method wherein data can be transmitted and/or received periodically and a second communication method wherein data can be transmitted and/or received asynchronously.

O'Brien (WO 92/12593) discloses an imagery data and text formatting mechanism for an image processing system in which a color photographic image on a color slide is digitally encoded and stored in bit map format on a compact disc.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

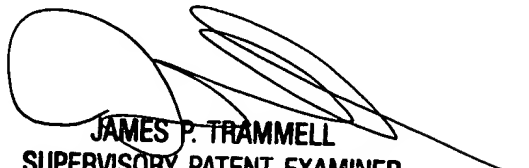
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 305-7687      (Official Communications; including After Final  
Communications labeled "BOX AF")  
(703) 746-5619      (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7<sup>th</sup> Floor Receptionist.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
March 5, 2003

  
JAMES P. TRAMMELL  
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